

the heating and controlled cooling. An area of the disk, called the power calibration area, is reserved for the purpose of laser power calibration. On CD-RW and DVD disks, the power calibration area is a small disc near the center of the disk. Before attempting to erase or write upon a disk, an optical disk drive will write a calibration pattern in the power calibration area of the disk. If the drive cannot read back the pattern, then the drive will not erase or write upon the disk. The present invention, as defined by the claims, covers, abrades or shields a power calibration area of a disk.

### III. Proposed Drawing Changes

Figures 1-3 are amended herein to be labeled as "prior art," as required by the Examiner. Formal drawings will be submitted upon allowance.

### IV. 35 USC §103 Rejections

Claims 1-11 stand rejected under 35 USC §103 as being obvious over "prior art" disclosed in the specification and Philips Electronics N.V., "CD Recordable & CD Writable," <http://www-eu.sv.philips.com/newtech/crtech/right.html> 8/9/98 (herein "the Philips document").

This rejection is respectfully traversed for three independent reasons. First, the Examiner has not established that the Philips document is prior art to the present application. Second, the references, even if available as prior art, fail to teach or suggest all elements of the claimed invention. Third, any motivation to add missing features to the references is the product of impermissible hindsight.

#### A. The Philips Document Cannot be Regarded as Prior Art

The Philips document does not have a known date of publication. The Philips document is an Internet document that the Applicant printed on August 9, 1998 and submitted on an Information Disclosure Statement dated August 26, 1998. The Applicant has never admitted that the Philips document is prior art. The only date appearing on the submitted print-out of the

The Philips document adds nothing to the Applicant's admitted prior art. The Philips document describes the program calibration area (PCA) of a CD-R or CD-RW disc, but the document never mentions a "ring" of any sort and certainly not a "ring having a portion that covers the power calibration area". Likewise, the Philips document does not mention "an abrasive tool", "shielding the power calibration area", or "covering the power calibration area".

Because neither the Applicant's admitted prior art nor the Philips document teaches or suggests the indicated limitations of the independent claims, no conceivable combination of the two references can yield the present invention. Therefore, the Applicant respectfully requests that the Examiner withdraw the rejection.

### C. Impermissible Hindsight.

To the extent that the rejection asserts that it would have been obvious to one of ordinary skill to add these missing elements to what the references teach, then the rejection is based upon impermissible hindsight.

A prima facie showing of obviousness requires a suggestion or motivation from the prior art. As explained in MPEP § 2143.03,

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure.

The Applicant respectfully submits that the suggestion or motivation is not present in the prior art, but has been taken from the Applicant's own disclosure. This is apparent by tracing through rejection.

The rejection first relies upon two admissions of prior art from the Applicant's specification: (1) that certain mechanisms for write protection are well known, and (2) that power calibration and a power calibration area are well known. The rejection proceeds to note that the Philips document discloses optimum power calibration using a program calibration area. The

document is the August 9, 1998 date of printing. Without any evidence of earlier posting or publication, the Examiner cannot assume that the Philips document was published at any time before this date. The Examiner certainly cannot assume that the Philips document was published before the Applicant's filing date, which was March 3, 1997. The Examiner is respectfully requested to either present proof that the Philips document is prior art to the Applicant's invention or withdraw the rejection.

In the event that the Examiner can either show that the Philips document qualifies as prior art or show by other means that the contents of the Philips document are part of the prior art, the Applicant still requests withdrawal of the rejection for two additional reasons, as the next two sections establish.

**B. The References Fail to Teach or Suggest All Claimed Elements.**

MPEP § 2143.03 informs us, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In this case, neither the Applicant's admitted prior art nor the Philips document teach or suggest a "ring having a portion that covers the power calibration area" (claim 1), "an abrasive tool . . . adapted to abrade the power calibration area" (claim 5), "shielding the power calibration area" (claim 6), or "covering the power calibration area" (claim 7).

Consider the only two admissions of prior art from the Applicant's specification: (1) that certain mechanisms for write protection are well known, and (2) that power calibration and a power calibration area are well known. The Examiner also notes that the Philips document discloses optimum power calibration using a program calibration area. However, claim 1 refers to a "ring having a portion that covers the power calibration area." The Applicant's specification in no way admits that such a "ring" was known in the prior art. No prior art discloses a "ring" that "covers" part of the medium or the power calibration area. Instead, the "ring" of claim 1 is part of the Applicant's advancement over the prior art. That is, the "ring" of claim 1 is a teaching from the Applicant and, therefore, is not part of the prior art from which the Examiner can rely. The same applies to the limitations quoted above from the other independent claims.

rejection states, "It is obvious when the power calibration area is covered (by any means, such as a ring, since it is a circular area), the laser power calibration becomes impossible, which this can affect the operation of the system such as preventing the disk from rewriting." This simply states that one can conclude, as an obvious matter, that an effect of covering the power calibration area is to prevent rewriting of the disk. However, this does not imply that it would have been obvious to cover the power calibration area in the first place. The effect of covering the power calibration area, given that it is covered, may be obvious, but the idea to cover, abrade, or shield it in the first place is not obvious.

Hence, the next statement of the rejection, "Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to cover the calibration area in order to affect the operation of the system, operation such as rewriting the disk," is logically incorrect. The rejection has not established obviousness to cover, abrade or shield the power calibration area. The Applicant's admissions of prior art are strictly limited to the two enumerated points listed above and do not extend to "the operation of the system, operation such as rewriting the disk." Likewise, the Philips document never mentions the cited motivation or anything similar.

Instead, the Examiner's motivation has been taken directly from the Applicant's own specification. Page 2, lines 5-7 of the specification states, "There is a need for a physical write protect feature, directly on the disk medium, that protects against writing for any software." On the same page, lines 18-24, the specification explains how the Applicant has achieved this objective:

In some example embodiments of the invention, the Power Calibration Area is temporarily obscured, preventing a successful calibration. For example, the Power Calibration Area may be covered by removable opaque plastic rings or adhesive labels. In other example embodiments, the Power Calibration Area is permanently obscured or covered for permanent write protection. For example, the surface of the disk in the Power Calibration Area may be scratched or abraded.

Because it is impermissible hindsight for the Examiner to use the Applicant's own teachings against him, the Applicant respectfully requests that the Examiner either produce

evidence from the prior art to show the motivation for modifying the references or withdraw the rejection.

### CONCLUSION

In view of the above remarks, it is respectfully requested that the rejections be withdrawn. The Applicant believes the claims are in condition for allowance. If the undersigned can assist in expediting the issuance of the application, the Examiner is invited to telephone the undersigned representatives.

Respectfully submitted,

**DRAFT**

Date: \_\_\_\_\_

Matthew C. Phillips Reg. No. 43,403

**DORSEY & WHITNEY LLP**

1330 Connecticut Avenue, N.W., Suite 200

Washington, D.C. 20036

Telephone: (202) 452-6900

Facsimile: (202) 857-0569